

REMARKS/ARGUMENTS

Claims 1 and 4-17 are pending in the application. The accompanying Request for Continued Examination and reconsideration of the application are hereby respectfully requested.

In the Claims:

All previously presented claims stand rejected for the following reasons:

Claims 1, 2, 3, 5, and 15 stand rejected under 35 U.S.C. §102(b) as anticipated by, or alternatively under 35 U.S.C. §103(a) as obvious over US 4,588,910 to Bausch.

Dependent claims 6-8, 13 and 14 stand rejected under 35 U.S.C. §103(a) as unpatentable over Bausch '910

Dependent claims 4, 9, 10, 11, 12, and 16 stand rejected under 35 U.S.C. §103(a) as unpatentable over Bausch '910 in view of other references.

Independent claim 17 stands rejected under 35 U.S.C. §103(a) as unpatentable over Bausch '910 in view of US 4,684,774 to Dibbern.

The Examiner maintains that Bausch '910 discloses a hand held tool including "a second manually operated switch member . . . located remotely (not integral with the switch unit) in a position that allows the user to see the switch during normal operation." The Applicant's disagree with the Examiner's assessment of the visibility of Bausch '910 reversing switch (9, 10, etc.) during normal operation. The location of the Bausch '910 reversing switch is effectively the same as the prior art described in the Background section of the subject application and shown in Fig. 1. As discussed at paragraph 0004 that location is difficult to view during normal use and, as is known by those of ordinary skill in the art, that location is usually covered by the tool user's hand.

Never-the-less, in order to expedite prosecution of the application, Applicants have further amended independent claim 1 to incorporate from claim 4 the limitation that

the second switch member “is located on an upward facing surface of the tool housing” and that the first switch member is “located adjacent to the integrated switch unit.” Claim 4 is correspondingly amended and claims 2 and 3 cancelled.

Applicants believe that amended independent claim 1 and independent claim 17 are allowable. Both independent claims 1 and 17 require a second manually operable switch member located in or projecting through the upper facing surface of the tool housing. Moreover, both independent claims 1 and 17 require an integrated switch unit including an electronic motor control unit.

The subject Specification makes clear that “the main switch and the forward/reverse switch are conveniently combined in a single integrated switch unit.” Paras 0002 and 0021. “An electronic control unit (8), is incorporated within the integrated switch unit.” Para 0021. “Such integrated switch units generally includes a first actuator which is actuated via a trigger. . . [and] a second actuator which can be moved between two positions a forward/reverse lever movable by a user.” Paras. 002 and 0021.

Neither Bausch ‘910 alone nor in combination with either Becker ‘642 or Dibbern ‘774 teaches or suggests the claimed combination of elements.

Bausch ‘910 teaches the prior art described in the Background section of the subject application. In Bausch ‘910 the on/off switch in housing 35 and reversing switch in housing 36 are (at least) physically integrated and are located together “in the region of transition between the pistol grip and the motor housing.” Bausch ‘910 col. 3 lines 1-14. Consequently, and as criticized in the subject Specification, the Bausch ‘910 on/off trigger switch 2 and manually operable reversing lever 9 and 11 are located in the same general location - in close proximity to the integrated switch unit and each other. Bausch ‘910 FIG. 1. Clearly, these Bausch switch members are not located in or projecting through an upward facing portion of the tool housing.

Regarding the proposed combination of Bausch '910 and Becker '642:

The Examiner has previously argued in regards to claim 4 that it would have been obvious to some how modify Bausch '910 with the reverse cap 22 of Becker '642, which is located on an upward surface of the Becker power tool. Becker '642, however, does not teach an integrated switch unit. Indeed, Becker '642 discloses three physically separate micro switches. In Becker '642 on/off microswitch 49 is located in physical contact with the trigger switch 14 in the handle 12 and underside of tool 10. Becker '642 col. 3 lines 28-46. Separate reverse control microswitch 41 and forward control microswitch 45 are located on opposite sides of the head portion 13 directly behind and directly actuated by the reversing cap 22. *Id.* and FIGS. 3 and 5. This construction is an extreme case of the prior art discussed in the subject Specification at para. 0005.

Firstly, regarding the Examiner's proposed combination of Bausch '910 and Becker '642, the Applicant's respectfully note that neither reference supplies the "linkage arrangement" required by independent claims 1 and 17. Becker '642 does not disclose a linkage because reversing cap 22 acts directly on micro switches 41 and 45. The Examiner has previously pointed to crank 25 of Bausch '910 as a "linkage assembly," but that crank does not teach or suggest a linkage that can move the actuator of the electronic control unit in response to positioning of the second switch member, when the second switch member is located on the top side of the tool and the integrated switch unit is located is located adjacent to the first switch member and/or in the handle.

Secondly, the proposed combination and the undisclosed modifications necessary to combine the disparate elements is neither motivated, taught nor suggested by the cited references of any other source identified by the Examiner. The grounds for rejection need to specifically identify the teaching and/or motivation that would lead one of ordinary skill in the art to select the references and combine them in the way proposed. *See In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). *See also* MPEP §2143.01. The cited references provide no motive for the combination. Bausch does not criticize its own arrangement and Becker does not

claim any advantage of its reversing cap location over an arrangement like that in Bausch. Both the motive and expectation of success must be found in the prior art and not in the Applicant's disclosure. *In re Vaeck*, 947 F2d 488, 493, 20 USPQ 1438 (Fed. Cir. 1991). Furthermore, even if there were motive to relocate the reversing switch in Bausch to the top of the tool, there is no teaching or suggestion about how to achieve it. *Compare, In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (while reversing a 35 U.S.C. §103 rejection, the court found no suggestive or incentive to combine two prior art landscaping and grading references to produce the applicant's simple lawn edging apparatus).

Regarding the proposed combination of Bausch '910 and Dibbern '774:

The Examiner has previously argued in regards to claim 17 that it would have been obvious to some how modify Bausch '910 with the reverse subassembly 62 of Dibbern '774, which includes a reversing button 79 located on an upward surface of the Dibbern power tool. Dibbern '774, however, does not teach an integrated switch unit. The Dibbern reverse subassembly 62 is itself a large switch that changes the direction of rotation of the motor by changing the electrical interconnections between contact elements 45, 46, 63, 70. Dibbern '774 at col. 9 lines 2-12. Meanwhile the Dibbern '774 on/off trigger switch 14 is apparently located in the convention location in the handle.

Thus, *mutatis mutandis*, the proposed combination of Bausch '910 and Dibbern '774, like the proposed combination of Bausch '910 and Becker '642 discussed above, does not disclose the required linkage between a reversing switch located atop a tool and a integrated switch unit located with a trigger switch in or near the handle underneath, nor do the cited references motivate, teach, or suggest the proposed combination and the necessary modifications needed to integrate the elements borrowed from those references. Furthermore, Dibbern '774 would appear to teach away from the proposed combination since it articulates numerous advantages in motor installation and control for its disclosed structure, which advantages would appear to be lost if the separate and distinct reversing mechanism described therein were replaced by the integral switch unit in Bausch '910.

Therefore, for the reasons given above, Applicants respectfully submit that independent claims 1 and 17 are novel and allowable over the prior art of record. Since the Applicant's believe they have demonstrated the novelty of independent claims 1 and 17, it is not necessary to separately address the rejections of dependent claims 5-16 and the various reasons given for those rejections.

Consideration of the accompanying Request for Continued Examination, and this Amendment is respectfully requested.

Respectfully submitted



Michael P. Leary
Registration No. 41,144
Attorney for Applicant(s)
February 15, 2006

Michael Leary - TW199
The Black & Decker Corporation
701 East Joppa Road
Towson, Maryland 21286
Telephone: (410) 716-2773